

ATTORNEY DOCKET NO. PHN 17,603 A  
U.S. SERIAL NO. 10/643,245  
PATENT

REMARKS

Claims 9-20 are pending in the application (the "Application").

Claims 9-20 have been rejected.

No claims have been allowed.

Claims 1-8 have been previously cancelled.

Claims 9, 11, 12, 15-20 have been amended.

Claims 9-20 remain in the application.

All arguments from previous amendments and responses are incorporated by reference and reiterated herein. Reconsideration of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 102(b)

In the Office Action of March 12, 2004 the Examiner rejected Claims 9-20 under 35 U.S.C. § 102(b) as having been anticipated by United States Patent No. 5,717,422 to Fergason ("Fergason"). The Applicants respectfully traverse the rejection.

It is axiomatic that a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131. *See, In re King*, 231 USPQ 126, 138 (Fed. Cir. 1986) (citing with approval, *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984)); *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is

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found in a single prior art reference. MPEP § 2131. *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985).

The Applicants respectfully draw the Examiner's attention to the unique and novel limitations in amended independent Claim 9 emphasized below:

9. (Currently Amended) A method of generating a desired image, comprising:

analyzing a first image to determine a desired brightness and a desired contrast for said first image;

providing an illumination beam from a constant intensity light source;  
modulating said illumination beam to produce an image beam having said desired contrast; and

optically adjusting a one of said illumination beam and said image beam to form said desired image having said desired brightness. (Emphasis added)

The Applicants respectfully assert that the *Ferguson* reference does not teach optical adjustment of an illumination beam or image beam to produce an image having a desired brightness.

The Sept. 30, 2004, Office Action stated that "In reference to Claim 9, *Ferguson* discloses a method of generating a desired image, comprising the acts of analyzing a first image, ref. 6, adjusting the first image to a desired contrast to form a second image and adjusting said second image for a desired brightness to form the desired image," referring without elaboration to column 3, line 66, through column 4, line 36. (Sept. 30, 2004, Office Action, Page 2, second paragraph).

Initially, the Applicants note that the Office Action does not assert that the *Ferguson* reference teaches the limitation that the first image is analyzed "to determine a desired brightness and a desired contrast for said first image." This unaddressed limitation was added by amendment in the Applicants' June 17, 2004, response to the March 12, 2004, Office Action. As such, the Sept. 30,

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2004, Office Action does not establish a *prima facie* case of anticipation, because it does not show that each and every limitation of the claimed invention is found in a single prior art reference.

The *Fergason* reference clearly describes a system having a variable intensity light source whose brightness is adjusted electronically. The computer control 5 controls the intensity or brightness of light source 2. *See Fergason, col. 4, lines 1-5, 19-21, 48-49.* By controlling the intensity of the light source, the power requirements of the *Fergason* apparatus are reduced, indicating that the intensity control is performed electronically. *See Fergason, col. 4, lines 40-42.* As such, the *Fergason* reference does not describe a constant intensity light source and optical adjustment of intensity to produce an image having a desired brightness, as recited in amended independent Claim 9. Because the reference does not show every element of the claimed invention, arranged as they are in the claim, the Applicants respectfully submit that amended independent Claim 9 is not anticipated by the *Fergason* reference.

Claims 10-18 depend directly or indirectly from Claim 9. The Applicants respectfully submit that Claims 10-18 contain the limitations of amended Claim 9 and are now in condition for allowance.

Amended independent Claims 19 and 20 recite analogous limitations to those in Claim 9 and, therefore, the *Fergason* reference does not anticipate Claims 19 and 20. The Applicants respectfully assert that these claims, too, are now in condition for allowance.

Therefore, the Applicants respectfully request that Claims 9-20, as amended, be passed to allowance. The Applicants respectfully deny any position or averment of the Examiner that is not

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specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of the Applicants' above stated position, as well as the right to introduce relevant secondary considerations including long-felt but resolved needs in the industry, failed attempts by others to invent the invention, and the like.

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**SUMMARY**

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@davismunck.com](mailto:wmunck@davismunck.com).

No fees are believed to be necessary. However, in the event that any fees are required for the prosecution of this application, please charge any necessary fees to Davis Munck Deposit Account No. 50-0208. No extension of time is believed to be necessary. If, however, an extension of time is needed, the extension is requested and please charge the fee for this extension to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Nov. 12, 2004

  
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